

## REMARKS

### I. Status of Claims

Claims 1-79 were filed with the application, and claims 67-79 have been canceled. Claims 9, 10, 24, 28-32 and 57-79 were withdrawn pursuant to a restriction requirement. Thus, claims 1-8, 11-23, 25-27 and 33-56 are under examination and stand rejected, variously, under 35 U.S.C. §112, second paragraph and 35 U.S.C. §103. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

### II. Rejection under 35 U.S.C. §112, Second Paragraph

Claims 1-8, 11-23, 25-27 and 33-56 stand rejected under the second paragraph of §112 as allegedly indefinite. Applicants traverse, but the claims have again been amended to clarify the issue of effective amounts. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

The examiner has stated that applicants' previous statements regarding the *in vitro* versus *in vivo* nature of the claims were not understood. Again, applicants submit that the *breadth* of the claims – and this is indeed a breadth issue – is not tantamount to indefiniteness. The claims do not specify *in vitro* or *in vivo* contexts. As such, they clearly encompass both. Thus, as stated previous, the claims are generic with respect to *where* the inhibition takes place. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

### III. Rejection under 35 U.S.C. §103

Claims 1-8, 11-23, 25-27 and 33-56 stand rejected as obvious over Konoplevea I or II in view of Castaigne, Drach or Estey. The examiner argues that both CDDO and retinoids have

been shown to treat leukemias, and hence, their combination to treat this same disease would be obvious. Further, the examiner argues that selection of the particular retinoid LGD1069 is obvious as well. Applicants traverse.

First, the Konopleva *et al.* (2002) reference, designated as C16, is not prior art against the instant application, as the instant application was filed on November 28, 2001, and the related provisional application was filed on November 28, 2000. Second, the Konopleva *et al.* (2000) reference, designated as C29, is available against the instant application only as §102(a) art given that it carries a face date of November 16, 2000, less than a month prior to the filing of the related provisional application. Applicants previously submitted a declaration under 37 C.F.R. §1.132 establishing that the non-inventor authors of that paper did not contribute conceptually to the subject matter therein (copy attached). Therefore, Konopleva *et al.* (2000) is *not* by another, and hence not available as prior art against the instant application.

Thus, having removed both primary references, applicants submit that the rejection can no longer stand. Reconsideration and withdrawal of the rejection is respectfully requested.

**IV. Conclusion**

In light of the foregoing, applicants respectfully submit that all claims are in condition for allowance, and an early indication to that effect is earnestly solicited. The examiner is invited to contact the undersigned attorney at (512) 536-3184 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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